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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,319	09/23/2003	Jerry Rayborn	P-0038US	9260

7590 09/09/2005

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EXAMINER	
TUCKER, PHILIP C	

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/667,319	RAYBORN, JERRY	
	Examiner	Art Unit	
	Philip C. Tucker	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1,3-9,11-22 and 24-32 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1,3-9,11-22 and 24-32 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 3-9, 11-17, 31 and 32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 and 36-41 of U.S. Patent No. 6,734,145. Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims do not teach the use of graphite, dependent claims such as 13 and 24 of US '145 teach that graphite may be used as a part of the fluid loss system, and the use thereof would render the present claims obvious to one of ordinary skill in the art.

Claims 1, 3-9, 11-17, 31 and 32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36, 46 and 47 of U.S. Patent No. 6,734,384. Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims do not teach

the use of graphite, dependent claims such as 13 and 29 of US '384 teach that graphite may be used as a part of the fluid loss system, and the use thereof would render the present claims obvious to one of ordinary skill in the art.

3. Claims 1, 3-9, 11-22 and 24-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-13, 15-17, 19-27, 29-39 of copending Application No. 10/667415. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the claims of 10/667415 differ in additionally teaching the use of talc, such uses the graphite in combination with the same components of the current claims and would render them obvious to one of ordinary skill in the art. With respect to claim 18, the steps taken concurrently are the equivalent of steps taken successively (Asbestos Shingle, Slate & Sheating Co. vs. Rock Fiber Mfg, 217 F. 66).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1, 3-9, 11-22 and 24-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-12, 14-20 of copending Application No. 10/667318. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the claims of 10/667318 differ in additionally teaching the use of talc, such uses the graphite in combination with the same components of the current claims

and would render them obvious to one of ordinary skill in the art. With respect to claim 18, the steps taken concurrently are the equivalent of steps taken successively (Asbestos Shingle, Slate & Sheating Co. vs. Rock Fiber Mfg, 217 F. 66). Furthermore, the specification of 10/667318 teaches the same beads and oils used herein and would render them obvious to one of ordinary skill in the art (see Vogel in MPEP 804).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel (5925182).

Patel teaches a suspension which may be used in wellbores, which can comprise an oil, a glycol and graphite (see claim 1). Patel differs in that a specific example of such a combination is not disclosed. It would however be obvious to one of ordinary skill in the art to utilize a combination of oil and glycol, with the graphite in the suspension of Patel, given the specific teaching of Patel that combinations of the liquid carrier may be used. Applicants claim is not seen to distinguish, since a combination of all components would be formed in the additive. Furthermore, the ranges of 1-99% of claim 32 would

clearly be rendered obvious by the teaching of the combination of carriers by Patel, since such covers almost the entire possible spectrum of relative amounts.

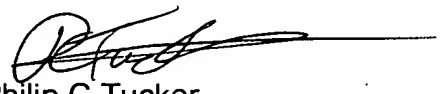
7. Claims 1, 3, 4, 6-9, 11-14 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rayborn (4063603) in view of DeBeer (5401719).

Rayborn teaches a drilling fluid additive comprising copolymer beads within the scope of the present invention as a lubricant (see column 2, lines 48-58). Rayborn further teaches that such can be added in a vegetable oil to the drilling fluid (column 3, lines 44-49). Rayborn differs from the present invention in that the use of graphite is not taught. De Beer teaches the use of graphite to improve lubrication properties of a drilling fluid (see column 2, lines 15-33). Case law has held that the utility of two or more compositions in combination, for that which they are individually taught useful is not a patentable distinction (In re Kerkhoven 205 USPQ 1069). It would be obvious to one of ordinary skill in the art to use the graphite mixture of DeBeerin combination with the mixture of vegetable oil and polymer bead of Rayborn, given that such are individually taught as being useful in forming a lubricant for addition to drilling fluids. This is particularly true since Rayborn teaches that combinations with other lubricants aids the function in the wellbore (column 3, lines 44-49).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C. Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-3844